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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,232	05/31/2000	Daniel J. Greden	MCS-119-99	2434

27662 7590 09/09/2004  
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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/584,232

Applicant(s)

GREDEN ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant's amendment of 8-17-04 traversed rejections of Claims 1 – 27.

Currently, claims 1 - 27 are pending.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claims 1 – 9, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974). For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While *Bowman* is not precedential, it has been cited for its analysis.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raveis, Jr (US Patent 6,321,202 B1) in view of Burge (US 6,014,638) and further in view of Rizzo (US 6,470,338 B1).**

Regarding Claim 1 and related claims 10 and 20, Raveis teaches a computer implemented method and system for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method comprising using a computer to perform the following process actions: - providing the buyer with an interactive environment having information relating to the products or services offered by the agents (Col 3, lines 41 – 45 and Figures 1 and 10).

However, Raveis does not specifically disclose and teach creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment; comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer.

On the other hand, Burge discloses and teaches creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment; comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer (see at least Abstract, Col 1, lines 7 – 16, Col 3, lines 1 – 17, Col 5, lines 16 - 37 and Figures 2A and B). Please note that Burge does not disclose agents. However, Burge does disclose merchants who as with agents describe products or services available for selection. In addition, Burge discloses buyers' profiles being constructed as result of their online interaction with the site. As result, the method and system of Burge match the appropriate seller/agent to the most appropriate buyer. In that regard, it would have been obvious to one of ordinary skill in the art to extend the method and system of Burge with a method and system that includes agents.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Raveis with the method and system of Burge to enable the ability for the computer implemented method and system to compare the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer and providing – in order to enable the ability of the method and system to automatically search and match agent specific criteria with appropriate buyers who fit their specific criteria such as buyers who can only afford homes in excess

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of 1 million dollars. Raveis discloses a method and system for providing the buyer with an interactive environment having information relating to the products or services offered by the agents (Abstract, Col 3, lines 41 – 45 and Figures 1 and 10). Burge discloses a method and system for creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment; comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer (see at least Abstract, Col 1, lines 7 – 16, Col 3, lines 1 – 17 and Figures 2A and B). Therefore one of ordinary skill in the art at the time of the invention would have been motivated to extend the method and system of Raveis with the method and system of Burge to create a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment; comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer. In that regard, the agent/merchant is match most closely with appropriate buyer and thereby ensuring that the buyer will have supporting them an agent/merchant who is most appropriate, which will also significantly improve the buyer's satisfaction. With the improved customer satisfaction, the customer's probability will increase that they will recommend the site/portal to others.

The combination of Raveis and Burge substantially disclose and teach the applicant's invention.

However, the combination does not specifically disclose providing the identity of the suitable buyer to the suitable agent.

On the other hand and in the same area of online services, Rizzo discloses and teaches providing the identity of the suitable buyer to the suitable agent (see at least Col 1, lines 54 – 57 and Col 2, lines 26 - 32).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Raveis and Burge with the method and system of Mini to have enabled providing the identity of the suitable buyer to the suitable agent. The combination of Raveis and Burge disclose a computer implemented method and system for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method comprising using a computer to perform the following process actions: - providing the buyer with an interactive environment having information relating to the products or services offered by the agents; creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment; comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer. Rizzo discloses a method and system providing the identity of the suitable buyer to the suitable agent (see at least Col 1, lines 54 - 57). Therefore, one of ordinary skill in the

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art would have been motivated to extend the combination of Raveis and Burge with the feature of providing the identity of the suitable buyer to the suitable agent. In this manner, the appropriate and suitable agent will be provided the identity of the buyer, which will increase buyer as well as agent satisfaction. The increased satisfaction on the part of the buyer will increase the probability that they will recommend the site to others.

Regarding claim 2 (original) and related claims 11 and 21, Burge teaches a computer implemented method and system, wherein the interactive environment includes allowing the buyer to graphically interact with information relating to the products or services (Figure 2A).

Regarding claim 3 (original) and related claims 13 and 23, Burge teaches a computer implemented method and system, wherein the buyer selects information relating to the products or services (Figure 2A).

Regarding claim 4 (original) and related claims 12, 14 and 22, Burge teaches a computer implemented method and system, wherein the profile is created based on the selections made by the buyer during interaction with the interactive environment (Col 3, lines 3 – 7).



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Regarding claim 5 (original) and related claims 15 and 24, Rizzo teaches a computer implemented method and system, wherein the interactive environment includes providing an interactive questionnaire to the buyer (Abstract).

Regarding claim 6 (original) and related claim 16, Rizzo teaches a computer implemented method and system, wherein the method and system operates on a computer-readable medium having computer-executable instructions for finding a prospective buyer and providing the buyer to an agent offering for sale at least one of products or services (Col 1, lines 40 – 43 and lines 54 - 57).

Regarding claim 7 (currently amended), Burge teaches a computer implemented method and system further comprising the process action of creating a database of buyer profiles and defining groups of specific criteria for specific buyers (Col 5, lines 22 - 25).

Regarding claim 8 (currently amended) and related claim 18, Raveis teaches a computer implemented method and system, further comprising the process action of providing agents access to the database to allow the agents to locate specific buyers based on criteria defined by the agents Col 8, lines 38 – 57).

Regarding claim 9 (original), Burge teaches a computer implemented, wherein comparing the profile and the inferred criteria with criteria of the products or services

includes matching specific products or services of the agents that the buyer has a potential interest in based on the generated profile of the buyer (Col 3, lines 1 - 12).

Regarding claim 17 (original), Burge teaches a computer system, wherein the comparator creates a database of buyer profiles and defines groups of specific criteria for specific buyers (Col 5, lines 22 - 24).

Regarding claim 19 (previously submitted), Burge teaches a computer system, wherein the comparator compares the profile and the inferred criteria with criteria of the products or services by matching specific products or services of the agents that the buyer has a potential interest in based on the created profile of the buyer (Col 3, lines 1 – 12 and Col 5, lines 16 - 35).

Regarding claim 25 (previously submitted) and related claims 26 and 27, Burge teaches a method, wherein comparing the profile and inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer is automatic (Col 5, lines 1 – 12 and Col 10, lines 27 - 45).

### ***Response to Arguments***

Applicant's arguments, filed 8/17/2004, with respect to the rejection(s) of claim(s) 1-27 under 35 USC 103(a) have been fully considered and are persuasive with respect

to Mini only. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rizzo (US 6,470,338 B1)).

Applicant argues regarding the 35 USC 101 rejection of claims 1- 9 is that the claims produce a "practical application".

With respect to these arguments, the "test" for 35 USC 101 consists of two parts. These are 1- Does the claimed method provide a useful, tangible and concrete result? And 2 – Does the claimed method steps in the body of claim recite and incorporate technology to carry out the recited steps? In that regard, claims 1- 9 do pass the first test but do not recite and incorporate technology to carry out the recited steps in the body of the claim. Moreover, the "test" is not based upon whether the claim has application in the technological arts but rather whether technology is used to carry out the recited steps in this business method application for patent. As a result, claims 1 – 9 fail the second test and therefore are not statutory.

Applicant argues that Raveis and Burge do not teach providing the identity of the suitable buyer to the suitable agent.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

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208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that there was no motive to combine the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the arguments are moot with respect to Mini. Of note, the method and system Burge are not completely automatic as alleged by the applicant. As noted in the reference as well recited in the claims, the profile is developed by the "interaction" of the buyer with the site. This interaction requires some manual effort by the buyer such as clicking on an item.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Davis (US 5,796,952), which discloses monitoring the uses interaction with an online site.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**


or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-7418** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER

  
Jeffrey A. Smith  
Primary Examiner